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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,771	06/27/2003	Lisa Keren Mentz Sievers	11045-3	6434

7590 07/13/2005
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EXAMINER

GREEN, BRIAN

ART UNIT PAPER NUMBER

3611

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/607,771	Applicant(s) SIEVERS, LISA KEREN MENTZ	
	Examiner Brian K. Green	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-20 is/are pending in the application.
 4a) Of the above claim(s) 10-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 14 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Handwritten signature/initials

DETAILED ACTION

Election/Restrictions

Claims 10-13 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on Sept. 17, 2004.

Drawings

The drawing change filed on April 25, 2005 has not been approved since the applicant failed to place "Replacement Sheet" in the top margin of the sheet as required under 37 CFR 1.121. Also, the crossed-out "FIG. 6" should not be shown on the sheet.

The drawings are objected to because in figure 6 each of the figures must be separately labeled, i.e. Fig. 6A, Fig. 6B. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

Claims 3-8 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 3 and 6, it is not clear how a spherical ornament can have three sides, i.e. how can a sphere have sides. In claim 18, line 5, it is not clear which message field the applicant is referring to.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Antenna Balls" .

"Antenna Balls" shows a spherical ornament having a first message (AMOCO) and a second message (the message located directly below AMOCO) which is different from the first message. In regard to claim 19, the detachable mount is considered to be the antenna in which the antenna balls are releasably attached to. The "Antenna Balls" was posted on Oct. 15, 1997 on the

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internet as shown by the website Wayback Machine. “Antenna Balls” does not disclose making the first message field incorporate a movie character and the second message field contain a reference to a movie. It would have been an obvious matter of design choice to modify “Antenna Balls” by making the first and second messages as defined in these claims since it is considered within one skilled in the art to make the indicia define any message as desired.

Printed matter that is not functionally related to the substrate does not distinguish the invention from the prior art; the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. See *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). In the present situation, there is no functional relationship between the printed matter and the substrate which carries it. Instead, the printed matter is merely carried by the substrate.

Claims 14 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Antenna Ball Promotions” .

“Antenna Ball Promotions” shows a spherical ornament having a first message (102.1 or MEP) and a second message (the message located directly below 102.1 or MEP) which is different from the first message. In regard to claim 19, the detachable mount is considered to be the antenna in which the antenna balls are releasably attached to. The “Antenna Ball Promotions” was posted on January 24, 2001 on the internet as shown by the website Wayback Machine. “Antenna Ball Promotions” does not disclose making the first message field incorporate a movie character and the second message field contain a reference to a movie. It would have been an obvious matter of design choice to modify “Antenna Ball Promotions” by

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making the first and second messages as defined in these claims since it is considered within one skilled in the art to make the indicia define any message as desired. Printed matter that is not functionally related to the substrate does not distinguish the invention from the prior art; the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. See *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). In the present situation, there is no functional relationship between the printed matter and the substrate which carries it. Instead, the printed matter is merely carried by the substrate.

Claims 14 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lund (U.S. Design Patent No. 294,843).

Lund shows in figures 1-6 a spherical ornament having a first message (eyes) and a second message (mouth/smile or the imitation stitching on the ball) which is different from the first message. In regard to claims 19 and 20, Lund shows in figures 1-6 that the mount includes a base (the projection on the clip), a shaft (the spring), and a surface attachment (the clip). Lund does not disclose making the first message field incorporate a movie character and the second message field contain a reference to a movie. It would have been an obvious matter of design choice to modify Lund by making the first and second messages as defined in these claims since it is considered within one skilled in the art to make the indicia define any message as desired. Printed matter that is not functionally related to the substrate does not distinguish the invention from the prior art; the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. See *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). In the present situation, there is no functional

relationship between the printed matter and the substrate which carries it. Instead, the printed matter is merely carried by the substrate.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Antenna Balls” in view of Haas (U.S. Patent No. 4,526,820).

“Antenna Balls” shows a spherical ornament having a first message (AMOCO) and a second message (the message located directly below AMOCO) which is different from the first message. The “Antenna Balls” was posted on Oct. 15, 1997 on the internet as shown by the website Wayback Machine. “Antenna Balls” does not disclose making a dark field with at least one star superimposed thereon and a striped field proximate to the dark field and having at least one star project outward from the surface of the ornament. “Antenna Balls” discloses the use of two messages but does not disclose the specific images of the messages defined by the applicant. It would have been an obvious matter of design choice to modify “Antenna Balls” by making a dark field with at least one star superimposed thereon and a striped field proximate to the dark field since it is considered within one skilled in the art to make the indicia define any message as desired. Printed matter that is not functionally related to the substrate does not distinguish the invention from the prior art; the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. See *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). In the present situation, there is no functional relationship between the printed matter and the substrate which carries it. Instead, the printed matter is merely carried by the substrate. Haas shows in figure 1 the idea of making the indicia

(17) raised from the surface of a device mounted onto an antenna. In view of the teachings of Haas it would have been obvious to one in the art to modify “Antenna Balls” by having some or all of the indicia placed on the surface of the ornament extending outwardly from the surface since this would create a more eye-catching and aesthetically pleasing display and would make the indicia more durable. In regard to claim 2, it is conventional in the art that antenna balls are about 1 to 2 inches in diameter. Further, the applicant defines in the specification, page 6, lines 10-11 that antenna balls have a diameter of between 1 and 2 inches. In regard to claims 3-8, it would have been an obvious matter of design choice to modify “Antenna Balls” by making the first and second messages as defined in these claims since it is considered within one skilled in the art to make the indicia define any message as desired. Printed matter that is not functionally related to the substrate does not distinguish the invention from the prior art; the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. See *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). In the present situation, there is no functional relationship between the printed matter and the substrate which carries it. Instead, the printed matter is merely carried by the substrate.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Antenna Ball Promotions” in view of Haas (U.S. Patent No. 4,526,820).

“Antenna Ball Promotions” shows a spherical ornament having a first message (102.1 or MEP) and a second message (the message located directly below 102.1 or MEP) which is different from the first message. The “Antenna Ball Promotions” was posted on January 24, 2001 on the internet as shown by the website Wayback Machine. “Antenna Ball

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Promotions” does not disclose making a dark field with at least one star superimposed thereon and a striped field proximate to the dark field and having at least one star project outward from the surface of the ornament. “Antenna Ball Promotions” discloses the use of two messages but does not disclose the specific images of the messages defined by the applicant. It would have been an obvious matter of design choice to modify “Antenna Ball Promotions” by making a dark field with at least one star superimposed thereon and a striped field proximate to the dark field since it is considered within one skilled in the art to make the indicia define any message as desired. Printed matter that is not functionally related to the substrate does not distinguish the invention from the prior art; the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. See *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). In the present situation, there is no functional relationship between the printed matter and the substrate which carries it. Instead, the printed matter is merely carried by the substrate. Haas shows in figure 1 the idea of making the indicia (17) raised from the surface of a device mounted onto an antenna. In view of the teachings of Haas it would have been obvious to one in the art to modify “Antenna Ball Promotions” by having some or all of the indicia placed on the surface of the ornament extending outwardly from the surface since this would create a more eye-catching and aesthetically pleasing display and would make the indicia more durable. In regard to claim 2, it is conventional in the art that antenna balls are about 1 to 2 inches in diameter. Further, the applicant defines in the specification, page 6, lines 10-11 that antenna balls have a diameter of between 1 and 2 inches. In regard to claims 3-8, it would have been an obvious matter of design choice to modify “Antenna Ball Promotions” by making the first and second messages as defined in these claims

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since it is considered within one skilled in the art to make the indicia define any message as desired. Printed matter that is not functionally related to the substrate does not distinguish the invention from the prior art; the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. See *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). In the present situation, there is no functional relationship between the printed matter and the substrate which carries it. Instead, the printed matter is merely carried by the substrate.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lund (U.S. Design Patent 294,843) in view of Haas (U.S. Patent No. 4,526,820).

Lund shows in figures 1-6 a spherical ornament having a first message (eyes) and a second message (mouth/smile or the imitation stitching on the ball) which is different from the first message. Lund does not disclose making a dark field with at least one star superimposed thereon and a striped field proximate to the dark field and having at least one star project outward from the surface of the ornament. Lund discloses the use of two messages but does not disclose the specific images of the messages defined by the applicant. It would have been an obvious matter of design choice to modify Lund by making a dark field with at least one star superimposed thereon and a striped field proximate to the dark field since it is considered within one skilled in the art to make the indicia define any message as desired. Printed matter that is not functionally related to the substrate does not distinguish the invention from the prior art; the

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critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. See *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). In the present situation, there is no functional relationship between the printed matter and the substrate which carries it. Instead, the printed matter is merely carried by the substrate. Haas shows in figure 1 the idea of making the indicia (17) raised from the surface of a device mounted onto an antenna. In view of the teachings of Haas it would have been obvious to one in the art to modify Lund by having some or all of the indicia placed on the surface of the ornament extending outwardly from the surface since this would create a more eye-catching and aesthetically pleasing display and would make the indicia more durable. In regard to claim 2, it is conventional in the art that antenna balls are about 1 to 2 inches in diameter. Further, the applicant defines in the specification, page 6, lines 10-11 that antenna balls have a diameter of between 1 and 2 inches. In regard to claims 3-8, it would have been an obvious matter of design choice to modify Lund by making the first and second messages as defined in these claims since it is considered within one skilled in the art to make the indicia define any message as desired. Printed matter that is not functionally related to the substrate does not distinguish the invention from the prior art; the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. See *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). In the present situation, there is no functional relationship between the printed matter and the substrate which carries it. Instead, the printed matter is merely carried by the substrate. In regard to claim 9, Lund shows in figures 1-6 that the mount includes a base (the projection on the clip), a shaft (the spring), and a surface attachment (the clip).

Claims 14 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lusebrink (U.S. Patent No. 3,320,920) in view of Katz et al. (U.S. Patent No. 5,176,099).

Lusebrink shows in figures 1-6 a spherical ornament having a mount that includes a base (20), a shaft (12) that is flexible and resilient, and a surface attachment (the suction cup or the adhesive 16). Lusebrink discloses the idea of varying the color of the spherical ornament, see column 2, lines 25-35. Lusebrink does not disclose placing first and second messages on the spherical ornament. Katz et al. shows in figures 4 and 5 the idea of placing a first message (40a) on the ball and a second message (40b) on the ball. In view of the teachings of Katz et al. it would have been obvious to one in the art to modify Lusebrink by attaching first and second messages to the spherical ornament since this would allow additional information to be conveyed to observers of the ornament. Lusebrink in view of Katz et al. do not disclose the specific messages defined by the applicant in the claims. It would have been an obvious matter of design choice to modify Lusebrink in view of Katz et al. by making the first and second messages as defined in these claims since it is considered within one skilled in the art to make the indicia define any message as desired. Printed matter that is not functionally related to the substrate does not distinguish the invention from the prior art; the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. See *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). In the present situation, there is no functional relationship between the printed matter and the substrate which carries it. Instead, the printed matter is merely carried by the substrate.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lusebrink (U.S. Patent No. 3,320,920) in view of Katz et al. (U.S. Patent No. 5,176,099) and Haas (U.S. Patent No. 4,526,820).

Lusebrink shows in figures 1-6 a spherical ornament having a mount that includes a base (20), a shaft (12) that is flexible and resilient, and a surface attachment (the suction cup or the adhesive 16). Lusebrink discloses the idea of varying the color of the spherical ornament, see column 2, lines 25-35. Lusebrink does not disclose placing first and second messages on the spherical ornament and having at least one star extend outwardly from the surface of the ornament. Katz et al. shows in figures 4 and 5 the idea of placing a first message (40a) on the ball and a second message (40b) on the ball. In view of the teachings of Katz et al. it would have been obvious to one in the art to modify Lusebrink by attaching first and second messages to the spherical ornament since this would allow additional information to be conveyed to observers of the ornament. Lusebrink in view of Katz et al. do not disclose the specific messages defined by the applicant in the claims. It would have been an obvious matter of design choice to modify Lusebrink in view of Katz et al. by making the first and second messages as defined in these claims since it is considered within one skilled in the art to make the indicia define any message as desired. Printed matter that is not functionally related to the substrate does not distinguish the invention from the prior art; the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. See *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). In the present situation, there is no functional relationship between the printed matter and the substrate which carries it. Instead, the printed

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matter is merely carried by the substrate. Haas shows in figure 1 the idea of making the indicia (17) raised from the surface of a device mounted onto an antenna. In view of the teachings of Haas it would have been obvious to one in the art to modify Lusebrink in view of Katz et al. by having some or all of the indicia placed on the surface of the ornament extending outwardly from the surface since this would create a more eye-catching and aesthetically pleasing display and would make the indicia more durable. In regard to claim 2, it is conventional in the art that antenna balls are about 1 to 2 inches in diameter. Further, the applicant defines in the specification, page 6, lines 10-11 that antenna balls have a diameter of between 1 and 2 inches. In regard to claims 3-8, it would have been an obvious matter of design choice to modify Lusebrink by making the first and second messages as defined in these claims since it is considered within one skilled in the art to make the indicia define any message as desired. Printed matter that is not functionally related to the substrate does not distinguish the invention from the prior art; the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. See *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). In the present situation, there is no functional relationship between the printed matter and the substrate which carries it. Instead, the printed matter is merely carried by the substrate. In regard to claim 9, Lusebrink shows in figures 1-6 a spherical ornament having a mount that includes a base (20), a shaft (12) that is flexible and resilient, and a surface attachment (the suction cup or the adhesive 16).

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Claims 14 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lund (U.S. Design Patent No. 294,843) in view of Katz et al. (U.S. Patent No. 5,176,099).

Lund shows in figures 1-6 a spherical ornament having a mount that includes a base (the projection on the clip), a shaft (the spring), and a surface attachment (the clip). Lund discloses the idea of placing a face on the spherical ornament. Lund does not disclose placing first and second messages on the spherical ornament. Katz et al. shows in figures 4 and 5 the idea of placing a first message (40a) on the ball and a second message (40b) on the ball. In view of the teachings of Katz et al. it would have been obvious to one in the art to modify Lund by attaching first and second messages to the spherical ornament since this would allow additional information to be conveyed to observers of the ornament. It would have been an obvious matter of design choice to modify Lund in view of Katz et al. by making the first and second messages as defined in these claims since it is considered within one skilled in the art to make the indicia define any message as desired. Printed matter that is not functionally related to the substrate does not distinguish the invention from the prior art; the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. See *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). In the present situation, there is no functional relationship between the printed matter and the substrate which carries it. Instead, the printed matter is merely carried by the substrate.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lund (U.S. Design Patent No. 294,843) in view of Katz et al. (U.S. Patent No. 5,176,099) and Haas (U.S. Patent No. 4,526,820).

Lund shows in figures 1-6 a spherical ornament having a mount that includes a base (the projection on the clip), a shaft (the spring), and a surface attachment (the clip). Lund discloses the idea of placing a face on the spherical ornament. Lund does not disclose placing first and second messages on the spherical ornament and having at least one star extend outwardly from the surface of the ornament. Katz et al. shows in figures 4 and 5 the idea of placing a first message (40a) on the ball and a second message (40b) on the ball. In view of the teachings of Katz et al. it would have been obvious to one in the art to modify Lund by attaching first and second messages to the spherical ornament since this would allow additional information to be conveyed to observers of the ornament. Lund in view of Katz et al. do not disclose the specific messages defined by the applicant in the claims. It would have been an obvious matter of design choice to modify Lund in view of Katz et al. by making the first and second messages as defined in these claims since it is considered within one skilled in the art to make the indicia define any message as desired. Printed matter that is not functionally related to the substrate does not distinguish the invention from the prior art; the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. See *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). In the present situation, there is no functional relationship between the printed matter and the substrate which carries it. Instead, the printed matter is merely carried by the substrate. Haas shows in figure 1 the idea of making the indicia (17) raised from the surface of a device mounted onto an antenna. In view of the teachings of Haas it would have been obvious to one in the art to modify Lund in view of Katz et al. by having some or all of the indicia placed on the surface of the ornament extending outwardly from the surface since this would create a more eye-catching and aesthetically

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pleasing display and would make the indicia more durable. In regard to claim 2, it is conventional in the art that antenna balls are about 1 to 2 inches in diameter. Further, the applicant defines in the specification, page 6, lines 10-11 that antenna balls have a diameter of between 1 and 2 inches. In regard to claims 3-8, it would have been an obvious matter of design choice to modify Lund by making the first and second messages as defined in these claims since it is considered within one skilled in the art to make the indicia define any message as desired. Printed matter that is not functionally related to the substrate does not distinguish the invention from the prior art; the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. See *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). In the present situation, there is no functional relationship between the printed matter and the substrate which carries it. Instead, the printed matter is merely carried by the substrate. In regard to claim 9, Lund shows in figures 1-6 a spherical ornament having a mount that includes a base (the projection on the clip), a shaft (the spring), and a surface attachment (the clip).

Response to Arguments

Applicant's arguments filed April 25, 2005 have been fully considered but they are not persuasive.

The applicant argues that claim 1-9 are now allowable since the prior art of record fails to disclose the idea of providing at least one three dimensional star on the surface of the ornament. The examiner has added the Haas patent to show that it is known to place three-dimensional indicia onto the surface of an ornament that is attached to an antenna.

The applicant argues that claim 14 is now allowable since the prior art of record fails to show an ornament for promoting a movie. The examiner disagrees since the particular message placed onto the ornament is considered to be a matter of design choice. Printed matter that is not functionally related to the substrate does not distinguish the invention from the prior art; the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. See *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). In the present situation, there is no functional relationship between the printed matter and the substrate which carries it. Instead, the printed matter is merely carried by the substrate.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (571) 272-6644. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bkg
July 8, 2005


BRIAN K. GREEN
PRIMARY EXAMINER